

Page



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/153,994	09/17/1998	NANCEY J. HAMMOND	660082.527M	6324

27076 7590 04/08/2004

DORSEY & WHITNEY LLP
INTELLECTUAL PROPERTY DEPARTMENT
SUITE 3400
1420 FIFTH AVENUE
SEATTLE, WA 98101

EXAMINER

BULLOCK JR, LEWIS ALEXANDER

ART UNIT	PAPER NUMBER
----------	--------------

2126

22

DATE MAILED: 04/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/153,994

Applicant(s)

HAMMOND, NANCEY J.

Examiner

Lewis A. Bullock, Jr.

Art Unit

2126

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-12,14-18,20-32 and 34-101 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6,8-12,14-18,20-27,32,34,35,39-72,74 and 87-98 is/are allowed.
- 6) ☒ Claim(s) 28-31,36-38,73 and 75-86 is/are rejected.
- 7) ☒ Claim(s) 99-101 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The indicated allowability of claims 28-31 and 36-38 are withdrawn in view of the newly discovered reference(s) of Nielsen (U.S. 6,108,688, Mohler (U.S. 6,175,859), Miloslavsky (U.S. 6,453,341), and Williams (U.S. 5,057,935). Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 28-31 are rejected under 35 U.S.C. 102(e) as being anticipated by NIELSEN (U.S. 6,108,688).

As to claim 28, NIELSEN teaches a method for a sender of an electronic message (e-mail message) to ensure that the electronic message is reviewed by a recipient (recipients), the computer implemented method comprising: determining whether after sending of the electronic message (e-mail message) to a recipient (recipient) a user specified amount of time (date and time specified by user through user interface controls) (col. 4, lines 20-31) has elapsed without receiving an indication that the recipient reviewed the sent electronic message (reply / response regarding non-

Art Unit: 2126

delivery / message has been opened or not) (col. 4, lines 52-65; abstract); and when it is determined that the period of time (date and time) has elapsed without receiving the indication (response), automatically requesting a confirmation from the sender to resend the electronic message (warn the sender that the message has not been opened by the intended deadline by displaying a dialog box); and when the confirmation is received from the sender (user selects OK button), resending the electronic message (the original message is resent to the recipient) (col. 5, lines 4-34; col. 6, lines 8-54; col. 7, line 31 – col. 8, line 28).

As to claim 29, NIELSEN teaches the electronic message (e-mail message) is sent to a plurality of recipients (recipients) (via selection of a plurality of recipients), and including receiving a specification of an amount of time for each recipient (via user manipulating user interface control to set the desired date and time) such that the automatic requesting of the confirmation is performed for each recipient when an indication that the sent electronic message was reviewed by that recipient is not received within the specified amount of time for that recipient (automatically warning the sender that the message has not been opened by the intended deadline by displaying a dialog box) (col. 4, lines 20-31 and 52-65; col. 5, lines 4-34; col. 6, lines 8-54; col. 7, line 31 – col. 8, line 28, abstract).

As to claim 30, NIELSEN teaches the requesting of the confirmation includes graphically presenting to the sender (user) a request to send the second electronic

Art Unit: 2126

message (via a dialog box being displayed), the request including a selectable confirmation element (OK Button) such that selection of the confirmation element indicates the confirmation of the sender (col. 4, lines 20-31 and 52-65; col. 5, lines 4-34; col. 6, lines 8-54; col. 7, line 31 – col. 8, line 28, abstract).

As to claim 31, NIELSEN teaches a method for guaranteeing delivery of e-mail messages by resending a message when it is determined that recipients have not responded to an initial message within a user selected pre-determined time period (col. 1, line 54 – col. 2, line 30; col. 4, lines 20-31 and 52-65; col. 5, lines 4-34; col. 6, lines 8-54; col. 7, line 31 – col. 8, line 28, abstract). It is inherent in the teachings of NIELSEN that when the subsequent messages are resent that they are sent similar to the initial message wherein the user request for notification of delivery or review from the recipients.

4. Claims 36 and 38 are rejected under 35 U.S.C. 102(e) as being anticipated by MILOSLAVSKY (U.S. 6,453,341).

As to claim 36, MILOSLAVSKY teaches a computer system for ensuring that an electronic message (e-mail) is reviewed by a recipient (answered by a support person), comprising: a message sender (e-mail server) for receiving an indication of the recipient for the electronic message and for sending the electronic message to the recipient (col. 5, lines 42-45); a message tracker (strategy part of router) for determining whether the recipient within a specified amount of time (predetermined time interval)

reviewed (answered) the electronic message sent by the message sender (col. 5, line 54 – col. 6, line 3); and a message processor (router) for automatically resending (re-routing) the electronic message when the message tracker determines that the recipient did not review (answer) the sent electronic message within the specified amount of time (predetermined time interval) (router re-routed to another support person) (col. 5, line 54 – col. 6, line 3).

As to claim 38, MILOSLAVSKY teaches sending another message when the message is not answered within the predetermined time interval (col. 5, line 54 – col. 6, line 3). It is inherent in the teachings of MILOSLAVSKY that when the subsequent message is resent that it is sent similar to the initial message wherein if it is not answered in the predetermined time interval, the message is re-routed to another support person.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over MILOSKAVSKY.

As to claim 37, MILOSKAVSKY teaches sending of an e-mail message to a recipient wherein when the message is not answered within the predetermined time interval another message is sent or resent (col. 5, line 54 – col. 6, line 3; abstract). However, MILOSKAVSKY does not teach that e-mail is directed to a plurality of recipients for reviewing the electronic messages within a predetermined amount of time. “Official Notice” is taken in that it is well known in the art that an e-mail message can be directed to a plurality of recipients and therefore when combined with Miloskavsky would allow for confirmation of answering an e-mail message of multiple requests from a plurality of recipients within a predetermined period of time.

Other Prior Art Teachings Relevant to the Cited Invention

- U.S. Patent 5,819,110 teaches the sending of e-mail messages that contain a request for acknowledgement of receipt and if an acknowledgement of receipt is not received within a predetermined time then another mode of communication is used to re-transmit the message.
- U.S. Patent 6,175,859 teaches the sender specifying a reply time at which it wishes to be informed of whether or not the recipient has accessed the sent message and responds accordingly whether a response has been received or not.
- U.S. Patent 5,057,935 teaches the automatically confirming of the receipt of an electronic document among a plurality of recipients.

Claim Rejections - 35 USC § 112

7. Claims 79-86 recite the limitation "the another message" in throughout the claims. There is insufficient antecedent basis for this limitation in the claim.

8. Claims 75-86 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: the sending of a second message. Claim 75 recites the sending of a third message. It is noted that a second message was never sent and therefore either the third message is the second message or Applicant is missing the step of sending a second message. Dependent claims 79-86, recite the sending of another message. Therefore, it can be inferred from the dependent claims that the sending of another message is the second message. Therefore, Applicant is requested to amend the claims to either make mention of the sending of the another message as part of independent claim 75 or recite the third message as the second message and amend the dependent claims accordingly.

9. Claim 73 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 73 dependent from claim 63 details when it is determined that the period of time has elapsed without receiving the confirmation within the second period of time, automatically sending a third electronic message. However, independent claim 63 details after receiving the confirmation, automatically sending a

Art Unit: 2126

third electronic message after a second pre-determined period of time. The examiner has found recitations wherein the another email is sent when the initial message is not received within a predetermined time interval and the sending of a message after confirmation of the message and after a time interval. However, the examiner has not found any recitation wherein the same message is sent in both cases. Therefore, claim 73 does not point out the invention since the third message is automatically sent after receiving the confirmation and after a second pre-determined period of time while also being sent when it is determined that the period of time has elapsed without receiving the confirmation within the second period of time.

Claim Objections

10. Claims 99-101 are objected to because of the following informalities: Regarding claim 99, the second claimed "when..." step should occur before the first claimed "when..." step. Appropriate correction is required.

Allowable Subject Matter

11. Claims 1-6, 8-12, 14-18, 20-27, 32, 34, 35, 39-72, 74, and 87-98 are allowed.

12. The following is a statement of reasons for the indication of allowable subject matter: The cited claims are allowable for at least the following reasons: All of the claims detail in part a sender of an electronic message ensuring the delivery and/or reviewing of the message by intended recipients by: determining whether after sending of the message a user-specified period of time has elapsed without receiving a

confirmation of delivery and/or review by each recipient; and when it is determined that the user-specified period of time has elapsed without receiving the confirmation, automatically resending the electronic message or automatically sending another electronic message. This cited teaching would enhance the reliability of communicating with electronic messages since messages are resent or reminder messages are sent in response to a user not receiving the message or not responding in a predetermined amount of time (pg. 1, line 14 – pg. 2, line 27). In addition the cited teaching allows for the user to handle the reliability of the communication by having the user specify the response time period. The various prior art of record come substantially close to Applicant's invention, however, none of the references meet the limitations of the invention individually or in combination. U.S. Patent 6,327,046 (Miyamoto) teaches the ensuring the handling of electronic messages by determining whether after sending of the message a user specified period of time has elapsed without receiving a reply by the recipient; and when it is determined that the user-specified period of time has elapsed without receiving the confirmation automatically resending the electronic message or automatically sending another electronic message (see abstract).

Applicant has overcome this teaching by filing a affidavit as proper under 37 CFR 1.131 indicating that the invention was conceive on/after 11/21/1997 superceding this prior art teaching. U.S. Patents 5,819,110 (Motoyama), 5,057,935 (Williams), and 6,453,341 (Miloslavsky) teach the sending of e-mail messages that contain a request for acknowledgement of receipt and if an acknowledgement of receipt is not received within a predetermined time then another mode of communication is used to re-transmit the

Art Unit: 2126

message. These teachings do not relate to Applicant's invention since the user does not handle the reliability of the e-mail communication by specifying the response time period. U.S. Patents 6,175,859 (Mohler) and 6,108,688 (Nielsen) teach the sender specifying a reply time at which it wishes to be informed of whether or not the recipient has accessed the sent message and responds accordingly whether a response has been received or not. The response can be the resending of the message through another delivery mechanism (Nielsen). This teaching does not relate to Applicant's invention since the handling of whether a response is received or not does not include the automatic resending of the message or automatic sending of another message. The cited prior art teachings also cannot be combined to alleviate the missing element from the other since this would potentially destroy the operation of the other. Therefore, the claims are allowable over the prior art of record. The cited claims also detail other limitations that are not met by the combination of teachings. For instance, the step of after receiving the confirmation, automatically sending a third electron message after a second user-specified period of time. These limitations add on to what is overall the ensuring of handling e-mail messages as detailed above and are allowable for those additional limitations as well.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lewis A. Bullock, Jr. whose telephone number is (703)

Art Unit: 2126

305-0439. The examiner can normally be reached on Monday-Friday, 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng An can be reached on (703) 305-9678. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "L. A. S. J.", is located in the lower right quadrant of the page.

lab